

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q81096
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____	Application Number 10/823,654	Filed April 14, 2004
	Confirmation Number: 4963 First Named Inventor Yoshio TERADA	
Signature Typed or printed name	Art Unit 1761	Examiner Lorna M. Douyon

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

- ☒ The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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65565

CUSTOMER NUMBER

I am the

- ☐ applicant/inventor.

/Keiko K. Takagi/

Signature

- ☐ assignee of record of the entire interest. See 37 CFR 3.71.
☐ Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34 _____

November 29, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- ☒ *Total of 1 form is submitted.

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q81096

Yoshio TERADA, et al.

Appln. No.: 10/823,654

Group Art Unit: 1761

Confirmation No.: 4963

Examiner: Lorna M. Douyon

Filed: April 14, 2004

For: CLEANING SHEET, CARRYING MEMBER WITH A CLEANING FUNCTION AND METHOD OF
CLEANING SUBSTRATE PROCESSING EQUIPMENT

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated June 29, 2010, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue: (1) claims 5, 8-9, 20 and 23 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Terada et al. (WO 03/052045) in view of Namikawa et al. (WO 02/05975); and (2) claims 5, 8-9, 20 and 23 are rejected on the ground of nonstatutory obviousness-type double patenting rejection over claim 14 of U.S. 7,575,790 in view of Namikawa

Applicants respectfully traverse the rejections and submit that one of ordinary skill in the art would not have been motivated to modify Terada in view of Namikawa.

Basically, the Examiner takes the position that it would be obvious to replace the cleaning layer comprising (meth)acrylic acid of Terada with a cleaning layer comprising polyimide resin

allegedly taught by Namikawa. The Examiner relies on the disclosure at page 5, line 19 to page 6, line 8 as a teaching in Namikawa of the use of polyimide.

While Namikawa may mention the use of polyimide, among other materials, at page 5, line 19 to page 6, line 8, a person of ordinary skill in the art would not have been led to replace the cleaning layer comprising (meth)acrylic acid of Terada with a cleaning layer comprising polyimide resin.

Terada discloses that its cleaning layer exhibits a 180° peel adhesion of 0.20 N/10 mm or less, preferably from about 0.010 to 0.10 N/10 mm; otherwise, the cleaning layer adheres to the non-cleaning area in the device during conveyance, possibly causing conveyance troubles.

Namikawa teaches the same problem as Terada and teaches the use of materials, such as acrylic polymers on page 11. That is, Namikawa also discloses that the 180° releasing adhesive force is not more than 0.20 N/10 mm, preferably about 0.010 to 0.10 N/10 mm. *See* page 10, lines 7-9. As specific materials to achieve the desired adhesive force, Namikawa discloses the use of acrylic polymers that contain (meth)acrylic acid and/or (meth)acrylic ester. *See* page 11, lines 3-7. There is no mention of the use of polyimide as a material suitable to obtain a releasing adhesive force in the desired range on pages 10-11. Indeed, it is submitted that there is no teaching or suggestion in Namikawa that the use polyimide provides a cleaning layer exhibit a 180° peel adhesion of 0.20 N/10 mm or less.

Given the desire in Terada for the cleaning layer to exhibit a 180° peel adhesion of 0.20 N/10 mm or less, and the teaching in Namikawa that acrylic polymers provide such a cleaning layer, it is submitted that a person of ordinary skill in the art would not be led to modify Terada to use a polyimide instead of an acrylic polymer.

As reiterated in *KSR*, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR*, 550 U.S. at 82 USPQ2d at 1396. Instead, the key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.

It is submitted that there is no apparent reason to modify Terada as proposed by the Examiner, and the Examiner has failed to provide a rational reason as to why a person of ordinary skill in the art would be motivated to do so, other than the mere fact that Namikawa mentions the term "polyimide" in its disclosure.

In addition, the Examiner asserts that poly(methylmethacrylate) and polyimide are "art recognized equivalents". The Examiner appears to be taking the position that simply because polyimide and poly(methylmethacrylate) are disclosed as being employable in an PSA polymer, they are equivalent.

It is submitted that the Examiner's position is contrary to MPEP §2144.06, which states "the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents." Simply because both poly(methylmethacrylate) and polyimide can be added to a PSA polymer is insufficient to support the position that poly(methylmethacrylate) and polyimide are equivalents.

In this regard, it is noted that principles such as "art recognizable" without providing an explanation of the applicability to the facts of the present case is insufficient to establish a *prima facie* case of obviousness. *See* Federal Register Notice of September 1, 2010 at page 53645.

Furthermore, it is submitted that since Terada does not disclose the use of polyimide and since Namikawa neither contains an Example where polyimide is used nor mentions silicone, a person of ordinary skill in the art would not reasonably expect each of the relative intensities of the recited fragment ions in the cleaning layer to be within the claimed ranges.

For at least the foregoing reasons, it is respectfully submitted that a *prima facie* case of obviousness has not been established, and that claims 5 and 8 are patentable over the cited art.

In addition, claims 9, 20 and 23 depend from claim 5 or 8, and thus it is submitted that these claims are patentable for at least the same reasons as claim 5 or 8.

Moreover, since the '790 patent corresponds to Terada, Applicants respectfully submit that claims 5, 8-9, 20 and 23 are not obvious over claim 14 of the '790 patent in view of Namikawa for the reasons discussed above.

In view of the above, Applicants respectfully request the Pre-Appeal Conference Panel to withdrawal the foregoing rejections.

Respectfully submitted,

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Date: November 29, 2010